

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER MASSEY

Appeal No. 2003-1660
Application No. 09/585,222

ON BRIEF

Before KIMLIN, TIMM, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 (2002) from the examiner's final rejection of claims 1 through 3 and 5 through 8 (final Office action mailed Feb. 1, 2002, paper 11), which are all the claims pending in the above-identified application.

The subject matter on appeal relates to (i) a barstock body fluid control valve (claims 1-3 and 5), (ii) a method of forming a barstock body fluid control valve (claim 6), (iii) a two port

fluid control valve (claim 7), and (iv) a three port fluid control valve (claim 8). Further details of this appealed subject matter are recited in independent claims 1, 6, 7, and 8 reproduced below:

1. A barstock body fluid control valve comprising:
a barstock body of preselected material having an inlet end and an outlet end, and a preselected cross section defining the outer walls;
a through machined main flow port located eccentrically on said inlet and said outlet ends;
wherein said main flow port eccentric location increases the available barstock thickness at one outer wall location and decreases barstock thickness in the opposite wall.

6. A method of forming a barstock body fluid control valve using reduced barstock size and a standard size valve stem, the method comprising the steps of:

selecting the reduced size barstock having a desired outer wall configuration formed about a longitudinal center line and cutting the reduced barstock size to length;

forming a valve body by machining flat surfaced ends on said reduced barstock size perpendicular to said barstock outer wall;

defining a throughbore axis offset from and parallel to the longitudinal centerline of the barstock;

machining a throughbore in said barstock symmetrically about the offset throughbore axis to produce an eccentrically located throughbore defining a thicker portion and a thinner portion of said barstock outer wall;

machining a valve stem bore perpendicular to said throughbore in the thicker portion of the barstock outer wall located a maximum distance from said offset throughbore axis;

selecting a standard size valve stem to be inserted in the valve stem bore in the thicker portion

of the barstock outer wall resulting in the thinner portion of the barstock wall positioned opposite the valve stem; and

installing the standard size valve stem in said valve stem bore.

7. A two port fluid control valve comprising:
a barstock body having outer walls extending between an inlet end and an outlet end defined by a preselected cross section circumscribed about a central longitudinal axis;

a machined through bore extending between the inlet end and the outlet end of the barstock body about an offset longitudinal throughbore axis parallel spaced from the central longitudinal axis,

the through bore is eccentrically located with respect to the outer walls producing a thicker outer wall portion and a relatively thinner opposite wall portion of the barstock body; and

wherein a stem port communicates perpendicularly with said throughbore machined through said thicker outer wall portion of the barstock body.

8. A three port fluid control valve comprising:
a barstock body having outer walls extending between an inlet end and an outlet end defined by a preselected cross section circumscribed about a central longitudinal axis;

a machined through bore extending between the inlet end and the outlet end of the barstock body about an offset longitudinal through bore axis parallel spaced from the central longitudinal axis,

the through bore is eccentrically located with respect to the outer walls producing a thicker outer wall portion and a relatively thinner opposite wall portion of the barstock body;

a machined bottom flow port formed perpendicular to said through bore through the thicker outer wall portion; and

a machined stem port communicates perpendicularly with said throughbore and axially aligned with said bottom flow port, said stem port machined through the thinner opposite wall portion of said barstock body.

The examiner relies on the following prior art

references as evidence of unpatentability:¹

Rawstron	3,345,032	Oct. 3, 1967
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Gonzalez	4,280,526	Jul. 28, 1981
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Claims 1 and 5 on appeal stand rejected under 35 U.S.C. § 102(b) as anticipated by Gonzales. (Answer, page 2; final Office action, page 2.) In addition, claims 1 through 3 and 5 through 8 on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Gonzalez in view of Rawstron. (Answer, page 3; final Office action, pages 2-3.)

We reverse these rejections.

35 U.S.C. § 102(b): Gonzalez

The examiner's basic position is that Gonzalez, in particular Figure 2, discloses every limitation of the invention recited in the appealed claims. (Final Office action, page 2; Answer, page 3.) We disagree.

¹ The examiner also refers to U.S. Patent 2,309,666 issued to Parker on Feb. 2, 1943 and U.S. Patent 3,417,450 issued to Zell on Dec. 24, 1968. (Examiner's answer mailed Sep. 20, 2002, paper 14, p. 5.) These references, however, have not been included in the statements of the rejections. Accordingly, we will not consider the teachings of these references as part of the evidence relied upon in the examiner's rejections. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of rejection.").

As pointed out by the appellant (appeal brief, pages 4-8), Gonzalez's specification contains no teaching regarding a "main flow port located eccentrically" such that it "increases the available barstock thickness at one outer wall location and decreases barstock thickness in the opposite wall," as recited in representative independent appealed claim 1. In addition, while Figure 2 may at first glance be viewed with a body portion 10a that seems to be thicker at the bottom relative to the top, Figure 1 clearly dispels such a notion as it shows that the main flow port is not located eccentrically as in the appellant's claimed invention.² Considering the teachings of the reference as a whole, we hold that Gonzales does not disclose, either expressly or inherently, every limitation of the invention recited in appealed claim 1 within the meaning of 35 U.S.C. § 102. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

35 U.S.C. § 103(a): Gonzalez and Rawstron

The examiner's position is stated as follows (final Office action, page 2):

Even if the Gonzalez [sic] does not disclose the eccentric bore, they are extremely well known through

² In this regard, we further note that 37 CFR § 1.84 (1980) did not require an applicant to submit drawings that are prepared "to scale," so Figure 2 in and of itself cannot constitute a specific description of the claimed invention.

out the art. It is deemed to be an obvious matter of design choice to make a flow passage eccentric. This element in the instant invention lacks criticality to make it an essential part of the invention.

The appellant, on the other hand, argues that the examiner has not identified any evidence to support a conclusion of obviousness. (Appeal brief, page 8.)

Because no relied upon evidence supports the examiner's conclusion, we must agree with the appellant (id. at pages 8-14) that the examiner has failed to make out a prima facie case of obviousness. It is not enough to merely allege that something is "well known," is an "obvious matter of design choice," or "lacks criticality" obviousness must be based on facts. In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry whether to combine references must be thorough and searching.'...It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with.").

In summary, we reverse the examiner's rejection under 35 U.S.C. § 102(b) of appealed claims 1 and 5 as anticipated by Gonzalez. We also reverse the examiner's rejection under 35 U.S.C. § 103(a) of appealed claims 1 through 3 and 5 through 8 as unpatentable over Gonzalez in view of Rawstron.

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REVERSED

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Catherine M. Turner

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